

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAWN CAREY

Appeal 2007-1440
Application 09/920,481
Technology Center 2100

Decided: July 11, 2007

Before JAMES D. THOMAS, JOSEPH F. RUGGIERO, and JOHN A. JEFFERY, *Administrative Patent Judges*.

JEFFERY, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant appeals under 35 U.S.C. § 134 from the Examiner's rejection of claims 1-30 and 41. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

STATEMENT OF THE CASE

Appellant invented a method of delivering items of content (e.g., electronic material such as document files, graphic files, sound and video files, etc.) to a user via email. The system delivers content from a storage location to remote client devices through email based inquiry-response automation.¹ Claim 1 is illustrative:

1. A method of delivering items of content from a storage location to client devices at remote locations through e-mail based inquiry-response automation, the method comprising the steps of

providing a content delivery system for customer support

storing plural items of content, wherein the plural items of content are technical support information

storing respective descriptions of the items of content and respective order codes for the items of content

receiving a first message via e-mail from a user of a given client device at a remote location, whereby an inquiry-response transaction is initiated

assigning a tracking code for the inquiry-response transaction

responding via e-mail to the first e-mail message with a prompt message, the prompt e-mail message including an arrangement of descriptions and order codes for a plurality of the items of content, the tracking code, and instructions to the user for ordering the items of content

receiving a second message via e-mail from the user

parsing the second e-mail message and identifying the tracking code in the second e-mail message

¹ See generally Specification ¶¶ 0007-0011 and 0019.

parsing the second e-mail message for at least one of the order codes specified by the user

extracting the items of content identified by the order codes in the second e-mail message

packaging the items of content from the extracting step into a single package unit

responding via e-mail to the second e-mail message with a response e-mail message comprising the single package unit comprising the items of content corresponding to the order codes in the second e-mail message.

The Examiner relies on the following prior art references to show unpatentability:

Gifford	US 5,724,424	Mar. 3, 1998
Talati	US 5,903,878	May 11, 1999
Schuster	US 6,351,524 B1	Feb. 26, 2002 (filed Jan. 20, 1999)
Joseph	US 2003/0028448 A1	Feb. 6, 2003 (filed May 10, 2001)

Appellant's admitted prior art at ¶ 0004 of the Specification ("APA").

1. Claims 1, 2, 4-6, 13, 14, 16-18, 22, 23, 25-27, and 41 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Gifford in view of Talati.
2. Claims 3, 15, and 24 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Gifford in view of Talati and further in view of APA.

3. Claims 7, 19, and 28 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Gifford in view of Talati and further in view of Joseph.
4. Claims 8-12, 20, 21, 29, and 30 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Gifford in view of Talati and further in view of Schuster.

Rather than repeat the arguments of Appellant or the Examiner, we refer to the Briefs and the Answer for their respective details. In this decision, we have considered only those arguments actually made by Appellant. Arguments which Appellant could have made but did not make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

OPINION

We first consider the Examiner's rejection of claims 1, 2, 4-6, 13, 14, 16-18, 22, 23, 25-27, and 41 under 35 U.S.C. § 103(a) as unpatentable over Gifford in view of Talati. In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). Furthermore, “‘there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness’ [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a

person of ordinary skill in the art would employ.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)).

If the Examiner’s burden is met, the burden then shifts to the Appellant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. *See In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

Regarding the independent claims, the Examiner's rejection essentially finds that Gifford teaches a method of delivering items of content through email based inquiry-response automation with every claimed feature except for (1) assigning a tracking code for the inquiry-response transaction, and (2) parsing the second email message and identifying the tracking code in the second email message as claimed. The Examiner cites Talati as disclosing an electronic commerce system that uses a Unique Global Transaction ID (UTID) to help identify the originator (user). The Examiner concludes that it would have been obvious to one of ordinary skill in the art at the time of the invention to use a tracking code such as a UTID in Gifford’s system to reduce fraudulent transactions (Answer 3-7).

Regarding representative claim 1,² Appellant argues that because the buyer initiates the transaction in Gifford by *clicking on a hyperlink* -- not via email -- the reference does not teach or suggest “receiving a first message *via e-mail* from a user of a given client device at a remote location, whereby

² Appellant argues independent claims 1, 13, 22, and 41 together as a group. *See* Br. 6-8. Accordingly, we select claim 1 as representative. *See* 37 C.F.R. § 41.37(c)(1)(vii).

an inquiry-response transaction is *initiated*” as claimed (emphasis added). Appellant emphasizes that skilled artisans would necessarily construe the term “email” as entirely incongruent with the term “hyperlink.” In support of this argument, Appellant argues that email messages are distinct from HTTP request messages in view of, among other things, their different protocols. Appellant also contends that, unlike email messages, HTTP request messages are composed by the user’s browser client software responsive to certain user actions (Br. 6-8; Reply Br. 5-6).

The Examiner argues that Gifford’s statement in column 7 regarding implementing an “electronic mail order system” at least suggests using email (Answer 11-12). The Examiner further contends that since Appellant did not ascribe a special meaning to the term “email,” it is interpreted with its plain meaning. As such, the plain meaning of “email” does not preclude an HTTP request (Answer 12-13).

We will sustain the Examiner’s rejection of representative claim 1. In Gifford’s network sales system, a buyer views an overview screen that is retrieved from a merchant computer. The screen includes links 1, 2, and 3 that, when activated, cause the buyer’s computer to take specified actions. As shown in Fig. 3, a document is retrieved with links 5, 6, and 7 that are used to purchase the products described by corresponding advertisements. (Gifford, col. 5, ll. 7-47; Figs. 2-5).

As shown in Fig. 6 of Gifford, when the user activates link 1, an HTTP request 20 results for a specific document with a specified URL. The merchant computer then retrieves the document and returns it to the buyer computer (Gifford, col. 5, ll. 49-59).

It is this HTTP request 20 that is the sole point of contention in this appeal. As Appellant indicates in the Reply Brief, the sole issue before us is whether an email message from the user would have been the same as, or an obvious variant of, an HTTP request message (Reply Br. 4). While we find that an HTTP request message is not necessarily the same as an email message, we nonetheless find that an email message would have been an obvious variant of an HTTP request message in Gifford. Moreover, associating email messages with hyperlinks is well known.

At the outset, we note that both the Appellant's and the Examiner's definitions of "email"³ share a common characteristic: sending messages over a network. Furthermore, we find that an HTTP request ultimately performs a commensurate function: it sends a message over a network. Although Appellant argues that an email message differs from an HTTP request message in "form, origin, and purpose,"⁴ both types of messages would nonetheless provide commensurate utility -- at least from the user's perspective -- when used to convey messages to the content delivery system in the manner claimed. That is, at least from the user's perspective, a message initiating the inquiry-response transaction would be sent from the client device to the content delivery system via a network, irrespective of whether an HTTP request message or an email message was used.

³ Appellant defines "email" in pertinent part as "[t]he exchange of text messages and computer files over a communications network...." (Br. 8). The Examiner defines "email" in pertinent part as "[t]he sending of messages by electronic means from one computer user to one or more recipients via a network...." (Answer 12).

⁴ See Reply Br. 4-5 (explaining distinctions between email messages and HTTP request messages).

In our view, using email in lieu of an HTTP request to initiate the transaction as claimed would have been an obvious variant in light of the commensurate functionality from the user's perspective achieved by both types of messages. Moreover, Appellant has not persuasively rebutted the Examiner's reliance on the teachings of Talati for the reasons stated on Page 5 of the Answer – a position that we find reasonable. For at least these reasons, we will sustain the Examiner's rejection of representative claim 1.

Additionally, we note that Gifford's system is based on Hypertext Markup Language (HTML) (Gifford, col. 4, ll. 61-65). As is well known in the art, a hyperlink in an HTML document is created by providing the appropriate tags with respect to certain displayed text along with the reference to the particular link.⁵

In addition to this standard hyperlinking capability, HTML also provides the capability to *open new email messages* when links are clicked. To this end, a hyperlink that is created using a special HTML tag ("mailto") facilitates sending email messages to a desired destination email address when the link is clicked.⁶

⁵ For example, to hyperlink the phrase "THIS IS TEXT" in an HTML document to a certain URL (e.g., www.uspto.gov), the following syntax is used: `THIS IS TEXT`. See *HTML Basics*, at

http://itsinfo.tamu.edu/workshops/handouts/pdf_handouts/html_basics.pdf, June 11, 2001, at 1-2 (last visited Jul. 2, 2007).

⁶ See *id.* at 3. For example, the following HTML syntax will create a hyperlink corresponding to a user's name ("John Doe") that will open a new email message addressed to `name@host` when the hyperlink "John Doe" is clicked: `John Doe`. See also *Entering Subject Using Mailto*, in *HTML Tips*, at www.digitalpoint.com/tips/html.html, June 6, 1996 (last visited Jul. 3, 2007).

In view of this well-known functionality of hyperlinks, we see no reason why the skilled artisan could not have provided a “mailto” capability associated with the hyperlink that initiates the transaction in Gifford. Such a capability would provide, among other things, the ability for the user to add other information to the request or query the merchant for specific information in conjunction with the request.

For the foregoing reasons, we conclude that receiving an email message responsive to the user’s activating a link in Gifford (i.e., via an HTML “mailto” function associated with the link) would have been well within the level of the skilled artisan.

In addition, we find that Talati is replete with teachings of using email in an electronic commerce transaction as a traceable delivery system. *See, e.g.*, Fig. 15 and col. 10, ll. 41-48 (noting that the client generates a purchase order that is formatted and transmitted to the merchant via an email message). In fact, a significant portion of Talati pertains to using email as a traceable delivery system. (*See* Talati, col. 8, l. 21 – col. 12, l. 46; Figs. 11-16). As Talati indicates, using email in this manner not only facilitates exchanging information, but also enables processing complex transactions and sharing information between multiple entities (Talati, col. 8, ll. 22-25).

In view of these collective teachings, the skilled artisan would have had ample reason on this record to enable the user to send the first message via email as claimed. For this additional reason, we will sustain the

(“Most people are aware of the MAILTO tag in HTML, which allows you to send mail to a particular address by clicking on a link.”).

Examiner's rejection of representative claim 1 based on the collective teachings of Gifford and Talati.

Likewise, we will sustain the Examiner's rejection of claims 2, 4-6, 13, 14, 16-18, 22, 23, 25-27, and 41 as they fall with representative claim 1. *See* 37 C.F.R. § 41.37(c)(1)(vii).

We will also sustain the Examiner's rejections under 35 U.S.C. § 103(a) of (1) claims 3, 15, 24 over the teachings of Gifford in view of Talati and further in view of APA; (2) claims 7, 19, and 28 over the teachings of Gifford in view of Talati and further in view of Joseph; and (3) claims 8-12, 20, 21, 29, and 30 over the teachings of Gifford in view of Talati and further in view of Schuster. We find that (1) the Examiner has established at least a *prima facie* case of obviousness for these claims on Pages 7-11 of the Answer, and (2) Appellant has not persuasively rebutted the Examiner's *prima facie* case. In this regard, Appellant merely noted that the additional references to APA, Joseph, and Schuster fail to cure the deficiencies of Gifford and Talati in connection with the previous arguments raised with respect to the independent claims (Br. 9). The rejection is therefore sustained.

DECISION

We have sustained the Examiner's rejections with respect to all claims on appeal. Therefore, the Examiner's decision rejecting claims 1-30 and 41 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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